

**REMARKS**

Claims 1-26 are pending in the above application. By the above amendment, claims 24-26 have been added.

The Office Action dated August 19, 2005, has been received and carefully reviewed. In that Office Action, claims 1-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto in view of Malik. Because it is believed that claims 1-24 patentably distinguish over the references of record, reconsideration and allowance of claims 1-24 is respectfully requested.

***Statement Of Substance Of Interview***

The Office Action rejects claims 1-23 under 35 U.S.C. 103(a) as being unpatentable over Sugiarto in view of Malik. However, the Office Action only mentions Malik in connection with claims 6, 8, 14, 19 and 22. The examiner explained during a telephone interview on September 14, 2005, that the claim rejections that do not mention Malik are intended to be obviousness rejections under 35 U.S.C. 103(a) based on Sugiarto alone. The rejection of claims 1-5, 7, 9-13, 15-18, 21 and 23 as being unpatentable over Sugiarto and the rejection of claims 6, 8, 14, 19 and 22 as being unpatentable over Sugiarto in view of Malik will therefore be addressed below.

***Office Action Does Not Address Arguments Presented In June 9, 2005, Amendment***

Section 707.07(f) of the MPEP provides:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.... Where

the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. If applicant's arguments are persuasive and upon reconsideration of the rejection, the examiner determines that the previous rejection should be withdrawn, the examiner must provide in the next Office communication the reasons why the previous rejection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks which form the basis for withdrawing the rejection. It is not acceptable for the examiner to merely indicate that all of applicant's remarks form the basis for withdrawing the previous rejection (emphasis added).

The August 19, 2005, Office Action acknowledged that Applicant's previously presented arguments were persuasive and that therefore the original rejections under 35 U.S.C. 102(b) had been withdrawn. This statement appears to be an acknowledgement that Sugiarto does not disclose each element required by the pending claims, and that Sugiarto must be modified in some manner if a rejection is to be maintained. However, the Office Action does not explain why the previous rejection under 35 U.S.C. 102(b) has been withdrawn as required by the MPEP. Knowing why the previous rejection was withdrawn would help Applicant better understand the new rejections. It is therefore respectfully requested that the examiner provide a further, non-final, Office Action explaining the basis for withdrawing the rejections under 35 U.S.C. 102(b).

Alternately, it is noted that the present rejections under 35 U.S.C. 103(a) are substantially the same as the original rejections under 35 U.S.C. 102(b). The arguments presented in response to the original rejections under 35 U.S.C. 102(b) are also believed to overcome the present rejections. In other words, it is believed that if the original arguments overcame the anticipation rejection based on Sugiarto they should also overcome the obviousness rejections that are based on Sugiarto because the rejections are nearly identical. It is therefore respectfully requested that the examiner address the substance of these original arguments (which Applicant

maintains and hereby repeats by reference thereto), in a further, non-final Office Action. The present rejections are also addressed below.

***Rejections Based On Sugiarto Alone***

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto. The Office Action acknowledges that Sugiarto “does not explicitly teach information data creation means for creating the information data by a search performed according to the information collection condition.” The Office Action does not explain how Sugiarto can be modified to include this missing element and does not provide any motivation for modifying Sugiarto in any manner. The Office Action merely includes the statement that “it is well known in the art of computing that in order to retrieve something, it has to be searched.” Applicant does not accept this statement for the reasons provided below. However, even if the truth of this statement could be established, it would not 1) identify a change to Sugiarto that would result in the claimed invention or 2) identify a motivation for making any change to Sugiarto to produce the claimed invention. The Office Action has acknowledged that Sugiarto must be modified by withdrawing the anticipation rejection and making a new rejection under 35 U.S.C. 103(a). However, the Office Action does not explain how Sugiarto is to be modified and does not provide any motivation for modifying Sugiarto, and therefore fails to make a *prima facie* case of obviousness.

Applicant does not agree with the statement “it is well known in the art of computing that in order to retrieve something, it has to be searched.” It is not clear, for example, why one would have to search for something if its location is already known. The examiner appears to be taking official notice of this statement. As provided in MPEP 2144.03, it “would not be

appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” It is respectfully submitted that the facts asserted above to be well known are not capable of instant and unquestionable demonstration. Furthermore, as provided in the same MPEP section, “if official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” It is respectfully requested that the examiner provide a technical line of reasoning supporting the reliance on official notice. Finally, MPEP 2144.03 provides “if applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.” By the above statement, Applicant challenges the factual assertion “it is well known in the art of computing that in order to retrieve something, it has to be searched,” and respectfully requests that the examiner support this statement with adequate evidence in a further Office Action.

The present Office Action indicates that Sugiarto’s configuration file corresponds to “client data corresponding to the client.” The Office Action also indicates that the configuration file is the means for setting an information collection condition when client data is modified. It also appears that the configuration file is supposed to correspond to the information collection condition itself. In other words, when the information in the configuration file is modified the configuration file sets itself to contain the information it already contains. This is not logical. At the very least, the configuration file takes no action that can be described as “setting.” It may

comprise data, it might be interpreted as a condition, but it in no manner sets anything else. The user sets the data in the configuration file manually; the file does no setting by itself.

For the above reasons, and the reasons provided in the June 9, 2005, Reply, it is submitted that claim 1 is allowable over the references of record, and reconsideration and allowance of this claim is respectfully requested. Claims 2-14 and 21-23 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto. The rejection of claim 15 states that Sugiarto teaches "information data creation means for creating the information data by a search performed according to the information collection condition." The rejection of claim 1, however, indicates that Sugiarto does not teach this limitation. The rejection of claim 15 is therefore word-for-word identical to the anticipation rejection of the first Office Action except that it is now stated to be based on Section 103(a). The Office Action has not addressed the arguments already presented in connection with claim 15 in the first Office Action. It is respectfully requested that, if claim 15 is still rejected under 35 U.S.C. 102(b), the examiner respond to the arguments that were previously provided. If this is a rejection under Section 103(a), it is respectfully submitted that no modification to Sugiarto has been identified and no motivation for modifying Sugiarto has been identified and that therefore a *prima facie* case of obviousness has not been presented. Claim 15 is submitted to be allowable over the art of record.

Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto. The rejection of claim 16 is word-for-word identical to the anticipation rejection of this claim in the first Office Action except that it is now stated to be based on Section 103(a). The Office

Action has not addressed the arguments already presented in connection with claim 16 in the first Office Action. It is respectfully requested that, if claim 16 is still rejected under 35 U.S.C. 102(b), the examiner respond to the arguments that were previously provided. If this is a rejection under Section 103(a), it is respectfully submitted that no modification to Sugiarto has been identified and no motivation for modifying Sugiarto has been identified and that therefore a *prima facie* case of obviousness has not been presented. Claim 16 is therefore submitted to be allowable over the art of record. Claim 17 depends from claim 16 and is submitted to be allowable for the same reasons as claim 16.

Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto. The rejection of claim 18 is word-for-word identical to the anticipation rejection of the first Office Action except that it is now stated to be based on Section 103(a). The Office Action has not addressed the arguments already presented in connection with claim 18 in the first Office Action. It is respectfully requested that, if claim 18 is still rejected under 35 U.S.C. 102(b), the examiner respond to the arguments that were previously provided. If this is a rejection under Section 103(a), it is respectfully submitted that no modification to Sugiarto has been identified and no motivation for modifying Sugiarto has been identified and that therefore a *prima facie* case of obviousness has not been presented. Claim 18 is therefore submitted to be allowable over the art of record.

***Rejections Based On Sugiarto And Malik***

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto in view of Malik. The Office Action states that Malik teaches “the database server set forth in

claim 1.” Applicant respectfully disagrees with this statement. Malik teaches a system that helps automate a password entry process at various web sites and tracks web site usage statistics. At the very least, Malik does not disclose the “information collection condition set means for setting, when the client data is modified, an information collection condition for specifying such information data as to be required by the client in future based on the modification” required by claim 1. It is possible that the Office Action intended to state that Sugiarto teaches the above limitations. Applicant traverses this statement for the same reasons provided in connection with claim 1.

The Office Action also states that Malik teaches “wherein the information collection condition set means sets the information collection condition with reference to a keyword table which corresponds to an attribute of client data.” On its face, the Office Action does not present a *prima facie* case of obviousness in connection with claim 6. The Office Action has not identified an element that is missing from a first reference, explained how a first reference is to be modified, or provided a motivation for making any modification at all. Motivation issues aside, column 9, lines 16-25 of Malik have nothing to do with the limitation quoted above. Thus, even if the references could somehow be combined, therefore, the result would not be the invention required by claim 6.

The same arguments apply to claims 8 and 14 and 22.

Independent claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto in view of Malik. Claim 19 requires a step of setting an information collection condition. The Office Action indicates that Sugiarto teaches this step at paragraphs 0020-0022. Although not specifically stated in connection with claim 19, it appears that this is a reference to

Sugiarto's configuration file. Sugiarto's configuration file includes a list of URL's and formatting information. The Office Action states that Sugiarto does not teach "changing an information collection condition automatically" and refers to Malik to address this shortcoming. However, the portion of Malik referred to in the Office Action discusses a history of web site usage and has nothing to do with an information collection condition. Moreover, Sugiarto's configuration file is set based on user preferences. The Office Action thus seems to suggest that the user's predefined preferences should be changed automatically for some reason based on Malik. Not only does Malik not show or suggest such a modification to Sugiarto, but changing Sugiarto as proposed would not result in the invention required by claim 19. Furthermore, the stated motivation for making this modification to Sugiarto, "to provide automated site navigation and manipulation for users" has nothing to do with Sugiarto or the claimed invention and therefore would not motivate one skilled in the art to change Sugiarto.

In view of the above, it is respectfully submitted that a proper motivation for combining the references has not been provided and that even if the references could properly be combined, the result would not be the invention required by claim 19. Claim 19 is therefore submitted to be allowable over the art of record.

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiarto. Claim 20 is stated to be rejected for the same reasons as claim 1 because "claim 20 is similar to claim 1." Claim 20 differs from claim 1 at least in that it requires information collection condition set means for automatically setting an information collection condition. This limitation is not present in claim 1. Other differences between claims 1 and 20 are also not addressed. The Office Action thus does not show how each limitation of claim 20 is present in or



obvious in view of the art of record. It is therefore respectfully requested that the present rejection of claim 20 be withdrawn or that the examiner provide a rejection of claim 20 that addresses all limitations of claim 20 in a further, non-final, Office Action.

New claims 24-26 are also submitted to be allowable over the art of record. Claim 24 specifically requires a step of inputting a search condition into a search engine. The use of a search engine is not shown or suggested by claim 24. Claim 25 specifically requires that the information retrieved not be specified by the stored client data. Thus, even if Sugiarto's configuration file is interpreted as client data, the stored URL's specify the data to be retrieved and thus Sugiarto does not satisfy the limitations of claim 25. Claim 26 even more specifically requires that the at least one client data being searched does not comprise a URL. Claim 26 distinguishes over the art of record for this reason as well.

### **CONCLUSION**

Each issue raised in the Office Action dated August 19, 2005, has been addressed, and it is believed that claims 1-26 are in condition for allowance. Wherefore, reconsideration and allowance of claims 1-23 and examination and allowance of claims 24-26 is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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